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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,046	06/28/2001	Kenneth McClure	873.0010.USU	5507

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EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/894,046	Applicant(s) MCCLURE, KENNETH	
	Examiner Jean A. Gelin	Art Unit 2681	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/15/05 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: 1-27.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: attached paper.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☐ Other: _____.

DETAILED ACTION

1. This is in response to the Applicant's arguments filed on April 15, 2005 in which claims 1, 26 have been amended, claims 27 has been added. Claims 1- 27 are currently pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6-10, 11, 16-20, 21-23, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (US 6,662,105) in view of Otting et al. (US 6,477,372).

Regarding to claims 1, 11, 21, 26, and 27, Tada teaches a method for operating a wireless communication system, comprising: determining a location of a mobile station (i.e., position calculation section 12a, col. 6, lines 59-61); comparing the location to information that is descriptive of a map that is stored in the mobile station (col. 6, lines 61-66); and deriving at least one system selection parameter from the mobile station's location relative to the map (col. 1, lines 40-44, col. 2, lines 3-31).

Tada does not specifically teach deriving at least one system selection parameter from the mobile station's location by which the mobile station may obtain access to a desired communication system.

However, the preceding limitation is known in the art of communications. Otting teaches the mobile station determines and scans for alternate technology to select the desired one typically according to the location of the mobile (col. 3, line 45 to col. 4, line 59). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Otting within the system Tada in order to allow the mobile station to perform alternate radiotelephone system scans without missing paging messages on the system where it is presently camped.

Regarding claims 6, 16, Tada in view of Otting all limitation above. Tada further teaches wherein the system selection parameter is used to select a non-public system (corresponding to information center, col. 7, lines 18-55).

Regarding claims 7, 17, Tada in view of Otting all limitation above. Tada further teaches wherein the determination of the location of the mobile station is performed by the mobile station without assistance from a network operator (i.e., the search for position of the mobile can be performed by the mobile col. 3, lines 10-15).

Regarding claims 8, 9, 18, and 19, Tada in view of Otting all limitation above. Tada further teaches wherein the determination of the location of the mobile station is performed by the mobile station with assistance from a network operator (mobile station can request search from information center, col. 2, lines 3-19, col. 3).

Regarding claims 10, 20, 22, and 25, Tada in view of Otting all limitation above. Tada further teaches wherein the map is downloaded from a network operator to a memory of the mobile station (col. 4, lines 18-44).

Regarding claim 23, Tada in view of Otting all limitation above. Tada further teaches wherein there are a hierarchy of maps, where a map that is lower in the hierarchy provides more a detailed system selection parameter than a map higher in the hierarchy (setting condition for map priority, col. 8, line 57 to col. 9, line 42).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5, 12-15, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada et al. (US 6,662,105) in view of Otting further in view of Dennisson et al. (US 6,324,404).

Regarding claims 2, 3, 12, 13, and 24, Tada in view of Otting teaches all limitation above except wherein the system selection parameter is comprised of a band of frequencies or a frequency channel within which the mobile station may obtain access to a desired system.

However, the preceding limitation is known in the art of communications. Dennisson teaches selecting desired frequency band to establish communication based on the exact geographic location of the mobile communication device (col. 12, line 50 to col. 13, line 20 and col.16, lines 1-33). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique

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of Dennisson within the system of Tada and Otting in order to encompass the switching of a dual frequency phone to a second frequency based on exact geographic location of the mobile device; thus, user who wants PCS for his communication device in the city is able to roam out of PCS territory into cellular territory.

Regarding claims 4, 14, the claim is interpreted and rejected for the same reason as set forth in the rejection of claims 2 and 3 above.

Regarding claims 5, 15, Tada in view of Otting teaches all the limitations above except wherein the system selection parameter is used to select a public system (corresponding to emergency system).

However, the preceding limitation is known in the art of communications. Dennisson teaches routing the emergency call based on the exact location geographic of the mobile communication device (col. 12, lines 15-50). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, to implement the technique of Dennisson within the system of Tada and Otting in order that the emergency response personnel can send someone more rapidly to rescue the caller of an emergency call.

Response to Arguments

6. Applicant's arguments filed 4/15/05 have been fully considered but they are not persuasive.

The Applicant argues that Tada describes a device that determines whether to obtain route-guiding data from a map stored locally in a mobile body or from a separate

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information center to display the vehicle location. The Applicant further argues that Tada in combination with Otting does not disclose deriving at least one system selection parameter from the mobile station's location by which the mobile station may obtain access to a desired communication system. The Applicant further argues that Otting teaches mobile station determines and scans for alternate technology without referencing to location of the mobile station.

However, the Examiner disagrees with the Applicant's argument. Otting teaches the mobile station determines and scans for alternate technology to select the best available network (col. 3, line 45 to col. 4, line 59) associated with the geographic location of the mobile station (col. 6, lines 12-32). As disclosed above, Tada teaches comparing the position of the mobile with the map data stored in section 14. The position of the mobile is determined based on the available network identification, and the mobile station is registered and camped on the best available network. Tada and Otting are in the same field of endeavor. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Otting within the system Tada in order to provide a system that allows mobile's user to receive service from different technologies. Thus, the drop calls would be avoided.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make

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the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969). In this case, the Applicant attempts to argue that Tada's route-guidance information is already obtained over the system for plotting the route against the map, so there is no need to derive such parameter. However, the Examiner would like to draw the Applicant's attention to the fact that Otting is cited to teach the idea of mobile station being able to switch to alternate technology while moving from one to another network, and simultaneous updating the location of the mobile. Therefore, the change of system and the change of location are correlated. The final rejection is maintained.

As per claims 8-9, and 18-19, none teach or suggest that the mobile station's location is obtained with assistance from a network operator. However, the Examiner disagrees with the preceding assertion. the claims are read on Tada wherein the mobile station requests map information from the information center (cols. 2-3).

As per claims 2-5, 12-15, and 24, the Applicant argues that Dennison does not teach deriving at least one system selection parameter from the mobile station's location relative...to obtain access to a desired communication system. However, the Examiner points out in the rejection above where Tada in view Otting teaches the preceding limitation. Dennison is cited only to teach the system selection is comprised

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of a band of frequencies or frequency channel. Dennison is not used to derive the system selection parameter. Therefore, the rejection is maintained and made final.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEAN GELIN
PRIMARY EXAMINER

JGelin
June 5, 2005

Jean A. Gelin